TFW 2145

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Application Number	09/533409-Conf. #8616
Filing Date	March 22, 2000
First Named Inventor	
Art Unit	2145
Examiner Name	A. M. Mirza
Attorney Docket Number	E0295.70106US00

Total Number of Pages in This Submission

ENCLOSURES *(Check all that apply)*

☐ Fee Transmittal Form	☐ Drawing(s)	☐ After Allowance Communication to TC
☐ Fee Attached	☐ Licensing-related Papers	☐ Appeal Communication to Board of Appeals and Interferences
☒ Amendment/Reply	☐ Petition	☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
☐ After Final	☐ Petition to Convert to a Provisional Application	☐ Proprietary Information
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☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	WOLF, GREENFIELD & SACKS, P.C.
Signature	
Printed name	Richard F. Giunta
Date	April 19, 2006
Reg. No.	36,149

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

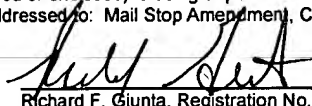|	
Applicant:	Yao Wang et al.
Serial No.:	09/533409
Confirmation No.:	8616
Filed:	March 22, 2000
For:	METHOD AND APPARATUS FOR PROVIDING ADDITIONAL RESOURCES FOR A HOST COMPUTER
Examiner:	A. M. Mirza
Art Unit:	2145

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 4/19/06

Richard F. Giunta, Registration No. 36,149

REQUEST FOR RECONSIDERATION

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action dated February 23, 2006, Applicants respectfully request reconsideration. To further the prosecution of this application, each of the rejections has been carefully considered and is responded to below. The application as presented is believed to be in allowable condition.

I. The History

In view of the lengthy pendency of the present application and the maintenance of rejections that Applicants do not believe to be appropriate, Applicants requested a telephone interview with Examiner Mirza and his supervisor Examiner Cardone to determine whether closure

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could be reached. The interview was conducted on October 20, 2005. As memorialized in the amendment filed on October 27, 2005, it was Applicants' understanding that at the conclusion of the discussion, Examiners Mirza and Cardone agreed that the claims distinguish over the prior art relied upon (i.e., Staheli in view of Miskowiec) and that the rejection would be withdrawn.

Applicants were surprised that the latest Office Action maintained the rejection, did not respond to any of the discussion that took place during the interview or the amendment made in Applicants' most recent filing, and appeared to be merely a cut and paste of a previous Office Action. Thus, the undersigned spoke with Examiner Mirza on April 4, 2006 (the substance of that discussion is summarized herein) requesting clarification. Examiner Mirza agreed to speak with his supervisor, and indicated that if Applicants filed a response, the rejection would be reconsidered.

In view of the fact that Applicants have already responded to the precise rejection laid out in the Office Action, copies of the arguments previously submitted are reproduced below. It is requested that if the Examiners believe that the rejection has not been overcome, they notify Applicants so that closure can be reached and an appeal pursued.

I.   The Double Patenting Rejection

Claims 1, 29, 45 and 52 are rejected under 35 U.S.C. §101 as purportedly claiming the same invention as claims 1, 7, 9 and 16 of U.S. Patent No. 6,898,727. This rejection is respectfully traversed.

The rejection set forth in the Office Action is a *statutory* double patenting rejection, which is contrasted with an obviousness type double patenting rejection in two significant ways. First, while a terminal disclaimer can be filed to overcome an obviousness type double patenting rejection it cannot overcome a statutory double patenting rejection. Second, the standard for applying a statutory rejection is far more stringent.

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No analysis is provided as to how the pending claims and those in the '727 patent are believed to be directed to the same invention. In addition, it is respectfully asserted that the rigorous standard for issuing a *statutory* double patenting rejection appears to have not been appreciated.

As discussed in MPEP §804(II)(A), the test for a statutory double patenting rejection:

> is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

There are numerous differences in the claims in the issued patent and the pending claims so there certainly are embodiments that fall within the scope of one of the claims but not the other. For example, a number of the independent claims in the '727 patent include a limitation relating to hosting an electronic commerce site, which is not a limitation in the pending claims.

In view of the foregoing, it is respectfully asserted that the statutory double patenting rejection is improper and should be withdrawn.

II.   The Arguments Submitted in the Amendment Filed May 5, 2005

The rejection of the claims then pending as purportedly being obvious over Staheli in view of Miskowiec was extensively addressed in the response filed May 5, 2005, and those arguments are reproduced below.

The Office Action rejects claims 1-61 under 35 U.S.C. §103(a) as purportedly being obvious over Staheli (5,537,533) in view of Miskowiec (5,915,095). Applicants respectfully traverse this rejection for the reasons stated below.

The Office Action asserts that Staheli discloses, "a method, comprising acts of: detecting a decrease in performance of a first host computer, wherein the first computer provides computational

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resources to perform a task." *See* Office Action, ¶2, page 2. Applicants respectfully disagree. During the telephone interview, Applicants pointed out that Staheli discloses manually bringing a remote replacement server online in case of failure of the primary server. *See* Staheli, Col. 5, lines 36-45. Staheli discloses that the replacement server and the primary server are never online at the same time, as at most, one instance of the network operating system runs at any time, even though each server has a copy of the operating system. *See* Staheli, Col. 5, lines 39-40.

Applicants pointed out during the telephone interview that Staheli relates to the complete failure of a computer, whereas claim 1, prior to the amendment made herein, recited, "detecting a decrease in performance of a first host computer" and "automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting, so that the first and second host computers simultaneously provide computational resources to perform the task." Staheli does not disclose detecting a decrease in performance in a server that continues to operate and the configuring of a second server to simultaneously provide resources to perform a task, but rather relates to preparing for and responding to a complete failure of a server and manually bringing a second server online to replace the failed server, such that the operation of the two servers is mutually exclusive.

During the interview, the Examiner questioned whether the phrase, "detecting a decrease in performance of the first host computer" in claim 1 was broad enough to encompass detecting a failure of the host computer. Applicants pointed out that a complete failure could not be considered a "decrease in performance" as recited in claim 1 because claim 1 requires that the first and second host computers simultaneously provide computational resources to perform the task. The failure of the first host computer and its replacement by the second host computer does not result in the two simultaneously providing computational resources to perform the task.

Applicants have made clear in the claims and in the prosecution history that a "decrease in performance" as used in the claims does not include a failure. For example, Applicants have presented this argument in at least one prior telephone interview and at least one previously submitted response (*See, e.g.,* Applicants Response mailed March 2, 2005, pages 16-17).

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Nevertheless, to make absolutely clear that the decrease in performance does not include a complete failure of the computer of the type described in Staheli, Applicants have amended claim 1 to recite, "detecting a decrease in performance of a first host computer that results from the first host computer continuing to function but at a decreased performance level, wherein the first computer provides computational resources to perform a task."

With respect to independent claims 29, 45, and 52, each of these claims previously recited that the first and second host computers simultaneously provide computational resources to perform the task. As stated above, the teaching in Staheli of bringing a replacement server online when a primary server has failed does not result in the two servers simultaneously providing computational resources to perform the task. Thus, the decrease in performance recited in these claims is clearly not a complete failure of the host computer. Nevertheless, to further clarify this point, Applicants have amended these claims to recite that the decrease in performance, "results from the first host computer continuing to function but at a decreased performance level."

During the telephone interview, the Examiner indicated that if it were made clear that a decrease in performance does not include a failure of the type described in Staheli, then he believed the claims would patentably distinguish over the combination of Staheli and Miskowiec. Understandably, the Examiner reserved final judgment on whether the claims would be in condition for allowance until after he had reviewed this response and the amendments made herein, but indicated that he would contact Applicants' representative if he felt that this Amendment did not place the application in condition for allowance.

In addition to failing to disclose detecting a "decrease in performance," Applicants respectfully point out that neither Staheli nor Miskowiec discloses or suggests, "automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting." The Office Action concedes that Staheli does not disclose this limitation and assumedly relies on Miskowiec to teach this feature. However, Applicants respectfully point out that the Office Action does not point to any disclosure of this feature in Miskowiec. The Office Action discusses Miskowiec generally, asserting that Miskowiec

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discloses an apparatus that relates to balancing a plurality of received processing requests among a plurality of servers, which may each run separate instances of the same application, and cites column 2, lines 52-61 of Miskowiec in support of this assertion. However, the cited portion of Miskowiec does not relate to automatic configuration of servers. Specifically, the cited portion of Miskowiec states:

> [a]n exemplary apparatus in accordance with the principles of the present invention concerns balancing a plurality of received processing requests among a plurality of servers. The processing requests are received from one or more network nodes. The apparatus includes a plurality of communication ports, a storage means, and a control circuit. A subset of the communication ports are in operative communication with at least a first server, a second server and a first network node. At least each of the first and the second servers are operative to run a common application.

Miskowiec, column 2, lines 52-61.

This paragraph does not disclose the automatic configuration of a server, neither in response to detecting a decrease in performance of another server, nor for any other purpose. Rather, this paragraph relates to balancing a plurality of processing requests among a set of previously-configured servers. There is no disclosure in Miskowiec of the automatic configuration of a server for any purpose. Thus, neither Staheli nor Miskowiec discloses or suggests, "automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting," as recited in claim 1.

Lastly, the Office Action asserts that one skilled in the art would have been motivated to combine Staheli and Miskowiec to, "have incorporated the automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting as taught by Miskowiec in the method of Staheli to substantially minimize a user's involvement in selecting a server to run a particular application with as prompt a processing time as is then available."

Applicants respectfully disagree that one of skill in the art would have been motivated by Miksowiec to modify Staheli to automatically configure a second server. However, even if one

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were to combine Staheli and Miskowiec, the combination would not have resulted in a system that involves automatically configuring a second host computer to provide additional resources for the first host computer in response to the act of detecting a decrease in performance of the first host computer, as neither Staheli nor Miskowiec discloses or suggests automatic configuration of computers.

For the foregoing reasons, claims 1-61 patentably distinguish over Staheli and Miskowiec, whether taken alone or in combination. Accordingly, it is respectfully requested that the rejection of claims 1-61 under 35 U.S.C. §103(a) be withdrawn.

III. The Arguments Submitted in the Response Dated October 27, 2005

The amendment filed on October 27, 2005 included a slight modification to the independent claims that followed as a result of the telephone conference with Examiners Mirza and Cardone where it was believed that agreement was reached that the claims distinguished over Staheli in view of Miskowiec. The arguments submitted in that response are reproduced below.

During the telephone interview, Examiner Cardone questioned whether it was clear in claim 1 that the act of automatically configuring the second host computer is done in response to detecting the decrease in performance of the first host computer. While Applicants believe that it was, claim 1 has been amended to indicate that the act of automatically configuring the second host computer is performed in response to "detecting the decrease in performance of the first host computer." This amendment is believed not to impact the scope of claim 1 in any respect.

The Office Action rejects claims 1-61 under 35 U.S.C. §103(a) as purportedly being obvious over Staheli (5,537,533) in view of Miskowiec (5,915,095). Applicants continue to respectfully traverse this rejection for the reasons set forth in the prior response filed May 5, 2005, which is incorporated herein by reference.

During the telephone interview, Applicants pointed out that Staheli discloses manually bringing a remote replacement server online in case of failure of the primary server. Thus, the

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replacement server and the primary server are never online at the same time, as at most, one instance of the network operating system runs at any time, even though each server has a copy of the operating system. *See* Staheli, column 5, lines 39-40. Thus, Applicants pointed out that Staheli does not disclose detecting a decrease in performance "that results from the first host computer continuing to function but at a decrease performance level," as recited in claim 1, because the only decrease in performance disclosed in Staheli is a complete failure of the primary server.

Applicants also pointed out that neither Staheli nor Miskowiec discloses or suggests, "automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting," as previously recited in claim 1. As discussed during the telephone interview, Miskowiec does not disclose the automatic configuration of a second host computer in response to detecting a decrease in performance of the first host computer, but rather, relates to balancing a plurality of processing requests among a set of previously configured servers.

Following the discussion, Examiners Mirza and Cardone agreed that the claims distinguish over Staheli in view of Miskowiec, and indicated that the rejection of claims 1-61 as purportedly being obvious over this combination would be withdrawn.

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CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Dated: April 19, 2006

Respectfully submitted,

By _____

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